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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,320	09/26/2003	Yohichiroh Watanabe	242938US0	5358

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EXAMINER

DOVE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/670,320	Applicant(s) WATANABE ET AL.	
	Examiner Janis L. Dote	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 8-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,8-20 and 22-27 is/are allowed.
- 6) ☒ Claim(s) 21 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/30/03; 11/29/05; 12/16/05; 2/17/06; 3/22/06</u> | 6) <input type="checkbox"/> Other: _____ |

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1. The examiner acknowledges the amendments to claims 1, 24, and 26 and the cancellation of claim 7 set forth in the amendment filed on Jan. 27, 2006. Claims 1, 3, and 8-28 are pending.

2. The information disclosure statement (IDS) filed on Dec. 30, 2003, does not comply with 37 CFR 1.98(a)(2)(iii), which requires legible copies of those portions of the copending U.S. patent application, i.e., copies of the originally filed claims and drawings of the US application, which caused it to be listed.

Since the submissions appear to be bona fide, applicants are given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections in the information disclosure statements. The examiner notes that if applicants have a postcard receipt stating that the USPTO did receive a copy of the missing documents, applicants should provide a copy of said receipt so that there is no ambiguity in the record that applicants did provide a copy of the missing documents.

NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b). Failure to timely comply with this notice will result in the above mentioned information disclosure statement being placed in the application file with the

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noncomplying information **not** being considered. See 37 CFR 1.97(i).

3. The examiner has considered the US applications listed on the "List of related cases" in the Information Disclosure statements filed on Nov. 29, 2005, Dec. 16, 2005, Feb. 17, 2006, and Mar. 22, 2006.

4. The submission of the missing copies of the originally filed claims, abstract, and figures, of the US applications listed in the "List of related cases" in the Information disclosure statement (IDS) filed on Sep. 26, 2003, filed on Nov. 29, 2005, fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e) or it lacks the necessary fee set forth in 37 CFR 1.17(p). The copies of the originally filed claims, abstract, and figures of the US applications listed in the "List of related cases" in the IDS filed on Sep. 26, 2003, filed on Nov. 29, 2005, have been placed in the application file, but the information referred to therein has not been considered.

Applicants were advised in the last office action mailed on Nov. 9, 2005, paragraph 3, that the date of any re-submission of any item of information contained in the information disclosure

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statement filed on Sep. 23, 2003, or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

5. Claims 1, 3, 8-20, 22-25, and 27 are directed to an allowable product for the reasons discussed in paragraph 6, infra. Pursuant to the procedures set forth in MPEP § 821.04(B), claims 26 and 28, which are directed to the process of making and to the process of using an allowable product, respectively, previously withdrawn from consideration as a result of a restriction requirement, have been rejoined and fully examined for patentability under 37 CFR 1.104.

Because all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement as set forth in the Office action mailed on Mar. 3, 2005, is hereby withdrawn. In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claims including all the limitations of an allowable product claim or rejoined process claim are presented in a continuation or divisional application,

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such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

6. The objection to the specification set forth in the office action mailed on Nov. 9, 2005, paragraph 5, has been withdrawn in response to the amended paragraph at page 13 of the specification, set forth in the amendment filed on Aug. 31, 2005.

The rejection of claims 1, 3, 8-11, 13, 14, 17, 18, 21-25, and 27 under 35 U.S.C. 103(a) over US 2003/0152859 A1 (Emoto'859), as evidenced by applicants' admissions at page 41, line 10, to page 42, line 8, of the instant specification, combined with US 4,980,257 (Anno), set forth in the office action mailed on Nov. 9, 2005, paragraph 11, has been withdrawn in response to the amendments to claims 1 and 24 set forth in the amendment filed on Jan. 27, 2006. Those amendments added the limitation of now-canceled claim 7 that the particulate crosslinked resin in the particulate material has a "weight average molecular weight of from 9,000 to 200,000." As discussed

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in the office action mailed on Nov. 9, 2005, paragraph 12, neither Emoto'859 nor Anno teaches or suggests such a particulate material having the molecular weight limitation recited in instant claim 7.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 21 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 is indefinite in the phrase "the binder resin comprises tetrahydrofuran-insoluble components in an amount of from 1 to 15% by weight based on the total weight of the binder resin." The amount of 1 to 15% by weight is outside the amount range of 2 to 30% by weight recited in instant claim 1, from which claim 21 depends.

Claim 28 is indefinite in the phrase "wherein the toner is the toner according to claim 1" (emphasis added) for lack of

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antecedent basis for the term "the toner" in claim 28. Claim 28 previously recites the step of passing an image material bearing a toner image thereon" (emphasis added). In other words, claim 28 recites a "toner image," not a toner.

Applicants' arguments filed on Jan. 27, 2006, with respect to the rejection of claim 21 above have been fully considered but they are not persuasive.

Applicants assert that the rejection of claim 21 "is moot in view of the cancellation of claim 21." However, the "Amendments to the claims" section filed on Jan. 27, 2006, did not cancel claim 21. Accordingly, the rejection of claim 21 stands.

9. Claims 1, 3, 8-20, and 22-27 are allowable over the prior art of record.

Claims 21 and 28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The claims are allowable over the prior art of record for the reasons discussed in paragraph 6, supra.

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10. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Mr. Nam Nguyen, can be reached on (571) 272-1342. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Apr. 4, 2006

Janis L. Dole
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PRIMARY EXAMINER
GROUP 1600
1700